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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,641

12/02/2005

Tatsuya Miyoshi

05825/HG

7279

1933

7590

05/27/2008

FRISHAUF, HOLTZ, GOODMAN & CHICK, PC

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EXAMINER

LAVILLA, MICHAEL E

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/27/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/559,641

Applicant(s)

MIYOSHI ET AL.

Examiner

Michael La Villa

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 9-18, 20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 9-18, 20, and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:
2. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-4, 9-18, 20, and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. Regarding Claims 1 and 18, the claimed surface-treatment coating is described as being formed by applying and drying a surface-treatment coating composition that contains ingredients (a) through (c). No defined amount of ingredient (a), or the resin solid content of ingredient (a), in the surface treatment coating composition is provided, and so the characterization of amounts of ingredients (b) and (c), defined in terms of amounts of resin solid matter in the water-epoxy resin dispersion, is indefinite in terms of defining what relative amounts of ingredients (a) through (c) are present in the coating composition. Analogous indefiniteness affects dependent claims that also refer to ingredient amounts by reference to the resin solid matter in the water-epoxy resin dispersion. See, for example, Claims 3, 4, and 20. With respect to Claim 1, the specification of ingredients following the phrase "on the surface coating:" is awkward since what follows is a description of the coating composition ingredients, not the coating. With respect to Claims 1 and 18, the description of ingredient (a), in general terms, as being a reaction of (A), (B), and . . . "compound" structured by (C) is

awkward since one would expect the third reaction component to be "C", not a compound structured as "(C)".

5. Regarding Claims 22-24, it is unclear what is the antecedent basis of the phrase "active-hydrogen containing compound" since the previous claim 1 appears to refer to two different compounds of this variety and previous Claim 16 refers to three such compounds. With respect to Claims 22 and 23, although these compounds may not be hydrazine derivatives, the rejection is appropriate to avoid a possibly improperly broadening claim.

Response to Amendment

6. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 9 October 2007. Rejection is withdrawn.
7. In view of applicant's amendments and arguments, applicant traverses the section 102 rejection over Miyoshi and the section 103 rejection over Miyoshi of the Office Action mailed on 9 October 2007. Applicant's priority document JP 2004-146334, having a filing date of 17 May 2004, discloses the claimed invention. Since the filing date precedes the publication date of Miyoshi, Miyoshi is unavailable prior art. Therefore, rejections are withdrawn.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is

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(571) 272-1539. The examiner can normally be reached on Monday through Friday.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael La Villa/
Michael La Villa
Primary Examiner, Art Unit 1794
22 May 2008